

REMARKS

Claims 1-35 and 37 are pending in the application, and all claims are rejected. With this response claims 1-14 and 25-31 are amended, claims 15-24 and 32-34 are canceled, and new claims 38-54 are added. All amendments and new claims are fully supported by the specification as originally filed. In particular, new claims 38-54 find support at least at page 8, paragraphs 44-48; page 9, paragraphs 52-57; page 10, paragraphs 60-66; and Figures 3 and 4. Applicant respectfully requests reconsideration and withdrawal of the rejections in light of the following remarks.

Specification

Applicant has amended paragraph [01] on page 1 of the specification to identify the parent application by application number and status.

Claim Rejections Under § 112

At section 5, on page 3 of the Office Action claims 25-34 are rejected under 35 U.S.C. § 112, second paragraph. Independent claims 25 and 30 are amended to correct an antecedent basis error in order to make clear that “a communication system” is distinct from “a mobile telecommunication network.” Therefore, applicant respectfully requests withdrawal of the rejections to claims 25-34 in light of this amendment.

Claim Rejections Under § 103

At section 7, on page 4 of the Office Action claims 1-10, 13-22, 25-35 and 37 are rejected under 35 U.S.C. § 103(a) as unpatentable over Heikkinen (WO 00/58920) in view of Turtiainen (U.S. Patent No. 6,430,407). Applicant respectfully submits that independent claim 1 is not disclosed or suggested by Heikkinen and Turtiainen, alone or in combination, because the cited references fail to disclose or suggest all of the limitations recited in claim 1. In particular, the cited references at least fail to disclose or suggest receiving at a mobile client at least one second secret in response to the at least one challenge, and using the second secret for authenticating the mobile client, as recited in claim 1.

Heikkinen addresses purchasing items from a vending machines, which includes authenticating the purchaser of the items. See Heikkinen page 6, line 18. Heikkinen discloses a “payment instrument unit” that receives requests from terminal equipment, and is used to authenticate the purchaser of an item. Authentication can be performed either

locally at the payment instrument unit, or by using a data transmission network. See Heikkinen page 7, lines 7-9. In either case, a challenge is transmitted to the terminal equipment, and then a private key is transmitted to the payment instrument unit in response to the challenge. The terminal equipment is authenticated to vending machine by the payment instrument unit based on this private key. In contrast, claim 1 recites that a second secret is received at a mobile client in response to at least one challenge, and the second secret is used for authenticating the mobile client. It is evident from claim 1 that the mobile client is authenticated to a communication system that is separate from a mobile telecommunication network. Therefore, in claim 1 the mobile client is authenticated to a communication system, instead of a vending machine as discussed in Heikkinen. For at least this reason, Heikkinen fails to disclose or suggest all of the limitations recited in claim 1.

Furthermore, in Heikkinen the private key is not received by the terminal equipment, but instead is generated by the terminal equipment in response to the challenge. In contrast, as recited in claim 1, the second secret is received at the mobile client in response to at least one challenge sent to a subscriber identity module, and the second secret is not generated by the mobile client. The mobile client of claim 1 is distinct from the terminal equipment discussed in Heikkinen, and the mobile client is authenticated based on a second secret that the mobile client receives. Therefore, claim 1 is not disclosed or suggested by the cited references, either alone or in combination, because the cited references fail to disclose or suggest all of the limitations of claim 1.

In addition, on page 4 of the Office Action, the Office acknowledges that Heikkinen does not disclose a mobile telecommunication network separate from a communication system to which the client is to be authenticated, and relies on Turtiainen for this teaching. However, there is no motivation to modify the teachings of Heikkinen by including an additional communication system to which a client is to be authenticated, because the terminal equipment of Heikkinen is authenticated to a vending machine. There is no suggestion, motivation or teaching that it would be desirable to authenticate the terminal equipment to a separate communication system. Therefore, for at least this additional reason, the cited references, either alone or in combination, fail to disclose or suggest all of the limitations recited in claim 1. As such, claim 1 is patentable over the cited references, and applicant respectfully requests withdrawal of the rejection to claim 1.

Independent claim 13, 25, 30, 35 and 37 all contain limitations similar to those recited in claim 1, and are rejected for the same reasons as claim 1. Therefore, for at least

the reasons discussed above in relation to claim 1, claims 13, 25, 30, 35 and 37 are not disclosed or suggested by the cited references, alone or in combination, and application respectfully requests withdrawal of the rejections to these claims.

Claims 2-10, 14, 26-29 and 31 all ultimately depend from an independent claim, and are patentable over the cited references at least in view of their dependencies. The rejection of claims 15-22 and 32-34 is rendered moot in light of the cancellation of those claims.

At section 8, on page 7 of the Office Action claims 11, 12, 23 and 24 are rejected under 35 U.S.C. § 103(a) as unpatentable over Heikkinen in view of Turtiainen and Lightman (U.S. Patent No. 6,711,414). Claims 11 and 12 ultimately depend from independent claim 1, and are patentable over the cited references at least in view of their dependencies. Claims 23 and 24 are cancelled, and therefore the rejection of these claims is moot.

New Claims 38-54

New independent claims 38 and 50 recite limitations similar to those of independent claims 13 and 30, respectively. Therefore, for at least the reasons discussed above in relation to independent claims 13 and 30, new claims 38 and 50 are not disclosed or suggested by the cited references.

New claims 39-49 depend directly or indirectly from new independent claim 38, and are patentable over the cited references at least in view of their dependencies. New claims 51-54 depend directly or indirectly from new independent claim 50, and are patentable over the cited references at least in view of their dependencies.

Conclusion

The objections and rejections of the Office Action having been obviated by amendment or shown to be inapplicable, applicant respectfully submits that the application is in condition for allowable and such action is earnestly solicited. The undersigned hereby authorizes the Commission to charge any fee deficiency required to submit this response to deposit account 23-0442.

Respectfully submitted,

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